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EXAMINER

LEROUX, ETIENNE PIERRE

ART UNIT PAPER NUMBER

2171

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7

Please find below and/or attached an Office communication concerning this application or proceeding.

on

## Office Action Summary

**Application No.**

09/966,313

**Applicant(s)**

ENTWISTLE, PAUL

**Examiner**

Etienne P LeRoux

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 9/26/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. ____.  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____.   | 6) <input type="checkbox"/> Other: ____.                                    |

*Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites “assessing at least one attribute of the document” and “with reference to the attributes and weighted values of the selectable locations for storage, selecting to locate said electronic document in at least one of the storage locations.” The scope of the present invention is difficult to determine because it is unclear what if anything the attributes of the document have to do with selecting to locate the document. Furthermore, it is unclear whether selecting to locate is actually storing the document in a memory location.

Claim 1 recites “assessing each location and allocating a weighting value to each location with respect to other locations.” It is unclear what comprises assessing a memory location. A possible difference between memory locations is not immediately apparent.

Claim 3 recites “a certain number of the storage locations with the strongest correlation values are presented for selection upon receipt of a document.” It is unclear what comprises a certain number and what comprises strongest correlation. Furthermore, it is unclear what presenting for selection actually means.

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Claim 13 recites “the correlation and selection of said storage location for the incoming document is made with respect to the information for said storage locations.” There is insufficient antecedent basis for the information.

Claim 15 recites “upon receipt of the e-mail, assessing at least one attribute of the e-mail and, with reference to the weighted values of the storage locations for storage, selecting to locate said e-mail in at least one of the storage locations.” The scope of the present invention cannot be determined because it is unclear how one attribute of the e-mail is assessed relative to the weighted values of the storage locations. It is difficult to determine how the location of a particular e-mail is selected.

Claim 18 recites “the attributes and weighting values are stored in a companion database with which the attributes of the received e-mail is compared rather than the actual content of each of the storage locations.” The scope of the present invention is unclear because it is not clear on what basis the e-mails are compared. Furthermore, it is unclear how an e-mail is assigned to a storage location if the content of the storage location is ignored.

Claims 2, 4-12 and 14 are rejected for being dependent from a rejected base claim.

Claims 16-18 are rejected for being dependent from a rejected base claim.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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Claims 1-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter for the following reasons:

MPEP § 2106 states:

Claims to computer-related inventions that are clearly non-statutory fall into the same general categories as non-statutory claims in other arts, namely natural phenomena such as magnetism, and abstract ideas or laws of nature which constitute descriptive material. Abstract ideas, *Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759, or the mere manipulation of abstract ideas, *Schrader*, 22 F.3d at 292-93, 30 USPQ2d at 1457-58, are not patentable.

A process that merely manipulates an abstract idea or performs a purely a purely mathematical algorithm is non-statutory despite the fact that it might inherently have some usefulness. In *re Sarkar*, 588 F.2d at 1335, 200 USPQ at 139.

Descriptive material can be characterized as either functional descriptive material or non-functional descriptive material. In this context, functional descriptive material consists of data structures and computer programs which impart functionality when employed as a computer component. When nonfunctional descriptive material is recorded on some computer-readable medium, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely, claiming nonfunctional descriptive material stored in a computer-readable medium does not make it statutory. Such a result would exalt form over substance. In *re Sarkar*, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978).

1) The preamble of claim 1 includes “a method of storage of electronic documents characterized in that said method includes the steps of.” The method steps following the preamble are not functional descriptive material recorded on computer-readable medium. The method steps are not statutory because technology is not required to permit the function of the method steps to be realized.

2) Claim 1 recites “assessing each location and allocating a weighting value to each location.” Assessing and allocating are mental processes for manipulating abstract ideas. Such

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contemplations do not impart functionality to a technological element such as a computer component.

3) The claim 1 limitation “assessing at least one attribute of the document” is a mental process which is mere manipulation of an abstract idea. Such a mental process is not directed to a functioning computer component.

4) The claim 1 limitation “selecting to locate the electronic document” is an abstract idea and is unrelated to the method of storing an electronic document as included in the preamble.

Examiner notes claim 1 covers the elements included in claim 15 and thus claim 15 is rejected for reasons similar to the above.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 6-8, 10, 11 and 14-17 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat No 5,915,251 issued to Burrows et al (hereafter Burrows), as best examiner is able to ascertain.

#### **Claim 1:**

Burrows discloses a method of storage of electronic documents said method includes the steps of:

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- the compilation of a list of possible storage locations for the documents within a document storage system [data structures 71 and summary data structures 72-73 per Fig 2 and col 4, lines 55-60]
- assessing each location and allocating a weighting value to each location with respect to other locations and in relation to specified attributes of each of the locations [parsing module 30 assigns increasing integer numbers to the locations per col 4, lines 50-53]
- upon receipt of an electronic document, assessing at least one attribute of the document [a word and its location per col 4, line 45],
- with reference to the attributes and weighted values of the selectable locations for storage, selecting to locate said electronic document in at least one of the storage locations [structures 71 and 72 can be stored on disk per col 4, line 64]

Claim 2:

Burrows discloses wherein for each incoming document, a correlation is made against a database representative of the filing properties of the storage location of the filing system which is being used to store the document [Fig 10 and col 13, lines 47-52].

Claim 3:

Burrows discloses a certain number of the storage locations with the strongest correlation values are presented for selection upon receipt of a document [Fig 3 and col 5, lines 61-66]

Claim 4:

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Burrows discloses if a correlation is matched for an incoming document, that document is stored in the matching storage location automatically [Fig 3 and col 5, line 62 through col 6, line 6].

Claim 6:

Burrows discloses as new documents are added into the filing system, the database of filing properties used for the correlation and analysis of storage locations is adapted to reflect the characteristics of the documents received [col 6, lines 12-14].

Claim 7:

Burrows discloses the method used is adaptive to reflect the characteristics of received documents [col 6, lines 12-14].

Claim 8:

Burrows discloses the storage location assessment occurs upon receipt of each new document [col 6, lines 12-14].

Claim 10:

Burrows discloses the attributes of the storage locations which are assessed are predefined by the system and/or the user [col 4, lines 40-53].

Claim 11:

Burrows discloses statistical significance values are assigned to the selected attributes [col 28, lines 18-27].

Claim 14:



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Burrows discloses the electronic documents received are e-mails [col 6, lines 44-48].

Claim 15:

Burrows discloses an e-mail reception and storage system, said system comprising a series of storage locations, each provided to receive selected e-mails characterized in that the selection of a particular storage location for a received e-mail is made by:

- assessing each location and allocating a weighting value to each location with respect to other locations and in relation to specified attributes of each of the locations [parsing module 30 assigns increasing integer numbers to the locations per col 4, lines 50-53]
- assessing at least one attribute of the e-mail and, with reference to the weighted values of the storage locations for storage, selecting to locate said e-mail in at least one of the storage locations a word and its location per col 4, line 45 and structures 71 and 72 can be stored on disk per col 4, line 64].

Claim 16:

Burrows discloses the received e-mail can be selected to be stored in more than one storage location [col 5, line 62 through col 6, line 6].

Claim 17:

Burrows discloses the weighting values and/or attributes are reviewed and if necessary revised as new e-mails are received and stored [col 6, lines 12-14].

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***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burrows as best examiner is able to ascertain.

Claim 5:

Burrows discloses the elements of claims 1 and 3 as noted above.

Burrows fails to disclose upon analysis of an incoming document, a matching correlation is not identified such that none of the presented storage locations are relevant, the incoming document is stored in a storage location using a conventional method of document filing.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Burrows to include upon analysis of an incoming document, a matching correlation is not identified such that none of the presented storage locations are relevant, the incoming document is stored in a storage location using a conventional method of document filing.

The ordinarily skilled artisan would have been motivated to modify Burrows per the above for the purpose of providing an initial storage for receiving the document.

Claim 18:

Burrows discloses the elements of claim 15 as noted above.

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Burrows fails to disclose the attributes and weighting values are stored in a companion database with which the attributes of the received e-mail is compared rather than the actual content of each of the storage locations.

Burrows discloses the attributes and weighting values are stored [Fig 3 and col 5, lines 61-66].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Burrows to include the attributes and weighting values are stored in a companion database with which the attributes of the received e-mail is compared rather than the actual content of each of the storage locations.

The ordinarily skilled artisan would have been motivated to modify Burrows per the above for the purpose of separating the storage elements.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Burrows in view of US Pat No 6,189,001 issued to McGovern et al (hereafter McGovern), as best examiner is able to ascertain.

Claim 9:

Burrows discloses the elements of claims 1, 7 and 8 as noted above.

Burrows fails to disclose the storage location assessment occurs at regular time intervals.

McGovern discloses the storage location assessment occurs at regular time intervals [col 7, lines 36-47].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Burrows to include the storage location assessment occurs at regular time intervals as taught by McGovern.

The ordinarily skilled artisan would have been motivated to modify Burrows per the above for the purpose of re-assessing the storage level assigned to the object [McGovern col 7, line 36].

Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burrows in view of US Pat No 6,212,517 issued Sato et al (hereafter Sato), as best examiner is able to ascertain.

Claim 12:

Burrows discloses the elements of claim 1 as noted above.

Burrows fails to disclose a companion database associated with the storage structure is provided, said database including statistically differentiating key words associated with particular storage locations and only these keywords are used in the correlation of the attributes of the incoming document and the available storage locations.

Sato discloses keywords are classified by attributes or statistical information [col 12, lines 35-54].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Burrows and Sato to include a companion database associated with the storage structure is provided, said database including statistically differentiating key words associated with particular storage locations and only these keywords

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are used in the correlation of the attributes of the incoming document and the available storage locations.

The ordinarily skilled artisan would have been motivated to modify the combination of Burrows and Sato per the above for the purpose of assisting the user by simplifying the display [Sato, col 12 line 35-40].

Claim 13:

The combination of Burrows and Sato discloses the elements of claims 1 and 12 as noted above.

Burrows fails to disclose the correlation and selection of the storage location for the incoming document is made with respect to the information for the storage locations in the companion database rather than the actual contents of the documents stored in the storage locations.

However, Sato discloses keywords are classified by attributes or statistical information [col 12, lines 35-54].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Burrows and Sato to include the correlation and selection of the storage location for the incoming document is made with respect to the information for the storage locations in the companion database rather than the actual contents of the documents stored in the storage locations.

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The ordinarily skilled artisan would have been motivated to modify the combination of Burrows and Sato for the purpose of assisting the user by simplifying the display [Sato, col 12 line 35-40].

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne LeRoux whose telephone number is (703) 305-0620.

The examiner can normally be reached on Monday – Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (703) 308-1436.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Patent related correspondence can be forwarded via the following FAX number (703) 872-9306

Etienne LeRoux

2/11/2004

